

600204528-9

REMARKS

Claims 1-37 are currently pending in the present application. Claims 1 and 2 are amended. Claims 31-37 have been withdrawn in response to Examiner's restriction requirement. Applicants note that a petition to rescind the restriction requirement is being filed concurrently.

A. Objections to Claims 1 and 2

In response to Examiner's objection to claim 1, the claim has been amended to clarify that the overlayer is substantially free of "particulate matter and substantially wax and pigment free." This corrects a typographical error.

In response to Examiner's objection to claim 2, the claim has been amended to clarify that "paniculate" is actually "particulate". This corrects a typographical error.

B. Rejection of Claims 1-30 under 35 USC §103(a) in view of Lever, et al.

Claims 1-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lever (EP 0458481). Applicants respectfully traverse the rejection and submit that claims 1-30 are not *prima facie* obvious in view of Lever. There is no motivation or suggestion in Lever to combine it with the knowledge of those skilled in the art to create Applicants' invention. In fact, Lever teaches away from the present invention.

Lever describes a polymeric sheet having a first coating layer of a lacquer and a second, overlayer, of a toner receptive material. Lever indicates at page 3, line 22 that the lacquer layer should preferably comprise finely divided particulate matter. This is useful in his application as a drafting film since this enhances the capture of writing on the sheet. Failure to add such matter, while indicated as being preferable, would negate the basic objective of the Lever invention, namely to provide a writable and printable surface. Applicants note that the examples include substantial amounts of particulate matter in the lacquer layer.

In contrast, claims 1 and 17 of the present application specifically recite that the overlayer and the underlayer are free of particulate matter.

The Examiner has indicated that the addition or deletion of the particulate additives is an obvious decision, based on the use of the substrate. While the Examiner is partially correct, additives could be added or subtracted depending on the use of the substrate, Applicants note that the use of particulate matter in coatings for substrates is common and the general practice in the industry. It is accepted that the presence of particulate matter in the substrate reduces the cost of manufacture and improves the strength characteristics of the substrate. As a result, it is not obvious

600204528-9

to take out the particulate matter. Applicants believe that absent art which teaches substrates without particulate matter, it is not obvious to remove it.

The art actually cited does not provide the Examiner with the motivation to provide a coating with no particulate matter. As discussed herein, Lever's objective use is to provide a substrate effective for drafting purposes, which seem to necessitate particulate matter. This teaches away from the Applicants' claims which claim a coating without particulate matter. Therefore, there is no motivation to modify Lever, which uses particulate matter to achieve its object, to provide a coating with no particulate matter. It is well settled that when the suggestion of the Examiner is to provide a change to Lever that goes against the underlying purpose of that invention, see MPEP §2143.01, there is no *prima facie* case of obviousness.

In addition, Examiner has indicated that it is incumbent upon the Applicants to show that the claimed parameters are not obvious in view of Lever. MPEP §2144.05 indicates that in a case where the claimed ranges overlap or lie inside ranges of the prior art, or, are close and would be expected to exhibit the same properties, a *prima facie* case of obviousness exists. In the present case, neither scenario is present and thus the claims are not obvious in view of Lever. The applicants are not required to respond unless there is a *prima facie* case.

Claims 15 and 16 of the present application provide that the underlayer has a weight of between 0.1 and 1 grams per square meter (for claim 15) and 0.3 and 0.5 grams per square meter (for claim 16). A weight corresponding to 1 gram per square meter corresponds approximately to a 1 micrometer thick layer. Lever on the other hand describes a minimum layer thickness of 2 micrometers and preferably, 3 micrometers. Thus, the thicknesses of the layers in the present invention are half or one-quarter of the absolute *minimum* thicknesses defined in Lever and less than 1/3 or 1/6 of the preferred minimum thickness. Therefore, there is no *prima facie* case of obviousness due to range overlap.

With regards to the expectation that the specified layer ranges in the present invention and Lever will exhibit the same properties, it can be presumed that Lever specified a minimum range for a reason. Because the substrate of Lever is utilized as a drafting material, it is likely that this is the minimum layer thickness that is necessary to resist an abrasive drafting instrument being drawn across its surface. Therefore, a thinner layer would not exhibit such a resistive property or Lever would have described using it. We can conclude from this that there is no *prima facie* case of obviousness due to expectation of similar properties.

Furthermore, Applicants note that the thickness of the layers is significant. First, any coating will change the color (or transparency) of the coated as compared to the uncoated substrate. This change is minimized by using thinner coatings. Second, the color of many polymer materials

600204528-9

changes with time and with exposure to UV. Having as thin a coating as possible is generally desirable, for stability of the results. Finally, coating materials cost money. Having a thin coating costs less than having a thick one. Thus, when a minimum coating thickness is defined in a publication, this is a direct teaching that it is undesirable to make the coating thinner.

Lever should thus be considered to teach away from the invention of claims 15 and 16, which claim a range of coating thicknesses much lower than even the minimum, not preferred, thickness of Lever.

Applicants believe that in light of the above amendments and remarks the claims in the application are in a condition for allowance. Notice to this effect is respectfully solicited.

Respectfully submitted,

Y. ALMOG, et al.

Dated: 9/15/5

By: Paul Fenster, Reg. No. 33,877

Paul Fenster, Reg. No. 33,877